United States Patent and Trademark Office

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,719	10/30/2003	Patrick J. Houle	082238.3000-101	8370

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EXAMINER
RINES, ROBERT D

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/697,719	HOULE ET AL.
	Examiner	Art Unit	
	Robert D. Rines	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 October 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/2/04*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Notice to Applicant

[1]   This communication is in response to the patent application filed 30 October 2003. It is

noted that this application is a Continuation in Part (CIP) of application 10/135,191 filed 29

April 2002. The IDS statement filed 2 April 2004 has been entered and considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[2]   Claims 1-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Freedman et al.

(United States Patent Application Publication #2002/0002475).

As per claim 1, Freedman et al. teaches a system for creating, monitoring, administering and adjudicating insurance contracts, comprising: a front-end subsystem in communication with at least one of a client (Freedman et al.; paragraphs [0027] [0097] [0103]), an insurance vendor and an insurance partner (Freedman et al.; paragraphs [0027] [0097] [0103]); a database subsystem accessing a plurality of stored databases (Freedman et al.; paragraph [0113]); and a back-end subsystem in communication with a plurality of subsystems to source information, monitor the creation, and administration of an insurance contract (Freedman et al.; paragraphs [0068] [0072] [0103] [0113]).

As per claim 2, Freedman et al. teaches a system wherein the front-end subsystem communicates via a network and is further operative with a set of executable instructions to collect contract information from and deliver contract information to a plurality of at least one of clients, vendors and partners (Freedman et al.; paragraphs [0097] [0111]).

As per claim 3, Freedman et al. teaches a system wherein the front-end subsystem comprises at least one of a set of executable instructions for quoting a plurality of terms of the contract, an enrollment process, a billing process and contract maintenance (Freedman et al.; paragraphs [0097] [0109] [0111] [0118]).

As per claim 4, Freedman et al. teaches a system wherein the back-end subsystem is in communication with a network and accesses the plurality of databases (Freedman et al.; paragraphs [0011] [0113]).

As per claim 5, Freedman et al. teaches a system wherein the back-end subsystem comprises a

system application having a quoting subsystem, an enrollment subsystem, a billing subsystem,

and a customer resource management subsystem (Freedman et al.; paragraphs [0067] [0072]

[0103] [0113]), and communicates with the front-end subsystem which in turn communicates

with the client and the insurance vendor to communicate the creation, execution and

management of the insurance contract (Freedman et al.; paragraphs [0068] [0072] [0103] [0111]-

[0115]).

As per claim 6, Freedman et al. teaches a system wherein the back-end subsystem further

comprises at least one of an underwriting and eligibility subsystem, a reporting subsystem, an

archiving subsystem, an electronic data interchange subsystem, a carrier management subsystem,

a knowledge base subsystem, an event triggering subsystem, a document management subsystem

and an auditing subsystem (Freedman et al.; Abstract and paragraphs [0109]-[0114]).

As per claim 7, Freedman et al. teaches a system wherein the front-end subsystem and back-end

subsystem access information through a graphical user interface (Freedman et al.; paragraphs

[0097] [0111]).

As per claim 8, Freedman et al. teaches in a data processing system, a method of implementing

insurance contracts between a client and an insurance provider comprising the steps of: receiving

a plurality of inputs for a quoting subsystem from the client (Freedman et al.; paragraphs [0068]

[0097] [0103]); processing the plurality of inputs and generating a quote in response to the

plurality of inputs (Freedman et al.; paragraphs [0097] [0109] [0111]); transmitting the quote to

the client (Freedman et al.; paragraphs [0097] [0109] [0111]); enrolling the client and executing

the insurance contract in response to receiving an approval with respect to the quote (Freedman

et al.; paragraphs [0111]-[0114]); processing claims in response to receiving a claim from the

client (Freedman et al.; Abstract); generating invoices that correspond to the insurance contract

using a billing subsystem (Freedman et al.; paragraphs [0022] [0067]); and monitoring and

managing the quoting subsystem process, a customer service process and the billing subsystem

(Freedman et al.; paragraphs [0067] [0097] [0109] [0118]).

As per claim 9, Freedman et al. teaches a method further comprising creating and storing in a

database a plurality of contract templates having terms and conditions of the contract (Freedman

et al.; paragraph [0111])

As per claim 10, Freedman et al. teaches a method further comprising reviewing eligibility and

underwriting requirements upon receiving the plurality of inputs from the client (Freedman et al.;

paragraphs [0111]-[0115]).

As per claim 11, Freedman et al. teaches a computer program product for implementing an

insurance contract between a client and a provider, the computer program product (Freedman et

al.; paragraphs [0022] [0028] [0159]) comprising: a computer usable medium having computer

readable code therein, including program code which: receives a plurality of inputs from at least

one of the client and the provider (Freedman et al.; paragraphs [0068] [0097] [0103]); processes the plurality of inputs (freedman et al.; paragraphs [0097] [0109] [0111]); generates a quote for the insurance contract for the client (Freedman et al.; paragraphs [0022] [0067]); enrolls the client and executes the insurance contract (Freedman et al.; paragraphs [0111]-[0114]); processes claims from the client (Freedman et al.; Abstract); generates corresponding invoices (Freedman et al.; paragraphs [0022] [0067]); and tracks and manages the plurality of inputs (Freedman et al.; paragraphs [0067] [0097] [0109] [0118]).

As per claim 12, Freedman et al. teaches a computer program product further comprising a set of executable instructions which creates a contract form containing terms and conditions of the contract (Freedman et al.; paragraphs [0111]-[0115]).

As per claim 13, Freedman et al. teaches a computer program product further comprising a set of executable instructions to track commission and premium payments (Freedman et al.; paragraph [0103]).

As per claim 14, Freedman et al. teaches in a computer network formed of a communication channel and a plurality of digital data processors coupled to the communication channel for communication thereon and a computer apparatus for implementing insurance contracts between a client and an insurance vendor, comprising: a front-end data processor to communicate with at least one of the client, the insurance vendor and an insurance partner, the client, the insurance vendor and the insurance partner communicating through a digital data processor (Freedman et

al.; paragraphs [0027] [0097] [0103]); a database data processor to access a plurality of stored

databases (Freedman et al.; paragraph [0113]); and a back-end data processor connected to a

plurality of subsystems on a plurality of digital data processors to create a rate comparison quote,

enroll the client, process and adjudicate claims, generate invoices and track client interactions

(Freedman et al.; paragraphs [0011] [0068] [0072] [0103] [0113]).

As per claim 15, Freedman et al. teaches a computer apparatus wherein the front-end data

processor communicates via a network and is further operative with a set of executable

instructions to collect contract information from the client and the insurance vendor to

subsequently deliver contract information to parties (Freedman et al.; paragraphs [0111]-[0115]).

As per claim 16, Freedman et al. teaches a computer apparatus wherein the front-end data

processor further comprises a set of executable instructions for collecting a plurality of client

inputs, providing form maintenance, vendor negotiations and contract maintenance (Freedman et

al.; paragraphs [0079] [0089] [0103]).

As per claim 17, Freedman et al. teaches a computer apparatus wherein the back-end data

processor is connected to a network and accesses the databases (Freedman et al.; paragraphs

[0011] [0113]).

As per claim 18, Freedman et al. teaches a computer apparatus wherein the back-end processor

comprises a quoting subsystem, an enrollment subsystem, a billing subsystem and a contact

resource management subsystem (Freedman et al.; paragraphs [0097] [0109] [0111] [0118]).

As per claim 19, Freedman et al. teaches a computer apparatus wherein the back-end processor comprises at least one of an underwriting and eligibility subsystem, a reporting subsystem, an archiving subsystem, an electronic data interchange subsystem, a carrier management subsystem, a knowledge base subsystem, an event triggering subsystem, a document management subsystem and an auditing subsystem (Freedman et al.; Abstract and paragraphs [0109]-[0114]).

As per claim 20, Freedman et al. teaches in a data processing system, a web-based method of implementing an-insurance contract between a client and an insurance carrier comprising: creating a new contract form which includes at least one provision of the insurance contract (Freedman et al.; paragraphs [0111]-[0115]); delivering the contract template to the client (Freedman et al.; paragraphs [0111]-[0115]); the client selecting the provisions of the contract and providing the preferences (Freedman et al.; paragraphs [0111]-[0115]); processing the preferences against eligibility and underwriting requirements (Freedman et al.; paragraphs [0111]-[0115]); enrolling the client in response to the processing of preferences (Freedman et al.; paragraphs [0111]-[0115]); processing any claims submitted by the client (Freedman et al.; Abstract); generating invoices that correspond to the insurance contract (Freedman et al.; paragraphs [0067] [0164]); and monitoring any client contact and information communicated during the creating and implementing of the insurance contract (Freedman et al.; paragraphs [0067] [0097] [0109] [0118]).

As per claim 21, Freedman et al. teaches a method further comprising processing the insurance contract using an event triggering subsystem (Freedman et al.; paragraphs [0111]-[0115]).

As per claim 22, Freedman et al. teaches a method wherein creating a new contract form comprises copying existing contract forms to create a new contract form (Freedman et al.; paragraphs [0111]-[0115]).

As per claim 23, Freedman et al. teaches a method wherein creating a new contract form comprises reading in a contract form created in an external environment (Freedman et al.; paragraphs [0111]-[0115]).

As per claim 24, Freedman et al. teaches a method wherein selecting the provisions of the contract comprises creating fields which indicate the selection of a particular insurance product (Freedman et al.; paragraphs [0027] [0097]).

As per claim 25, Freedman et al. teaches a method wherein selecting the provisions of the contract comprises copying existing preference fields from existing contract templates (Freedman et al.; paragraphs [0098] [0099] [0111]-[0115]).

As per claim 26, Freedman et al. teaches a method wherein selecting the provisions of the contract comprises reading in preference fields created in an external environment (Freedman et al.; paragraphs [0098] [0099] [0111]-[0115]).

As per claim 27, Freedman et al. teaches a method wherein the external environment comprises a vendor website, a third party website, a vendor database and a third party database (Freedman et al.; paragraphs [0113] [0125] [0126] [0130]).

As per claim 28, Freedman et al. teaches a method further comprising creating a plurality of versions of the same contract template with differing selections (Freedman et al.; paragraphs [0111]-[0115]).

As per claim 29, Freedman et al. teaches a method wherein said contract template is in the form of a computer database record structure, wherein each field of the record structure denotes one of an input data term of the contract and a key that points to the data term (Freedman et al.; paragraph [0111]).

As per claim 30, Freedman et al. teaches method further comprising tracking premium and commission payments (Freedman et al.; paragraph [0103]).

As per claim 31, Freedman et al. teaches a computer-readable data transmission medium between a plurality of computers having a data structure comprising: a first subset of data for processing at a first computer, the first subset of data including terms and conditions for an insurance contract (Freedman et al.; paragraphs [0111]-[0115]); and a second subset of data for

processing at a second computer, the second subset of data including a template having the terms and conditions of the contract (Freedman et al.; paragraphs [0111]-[0115]), the terms and conditions being modifiable at the second computer to accommodate a user preference (Freedman et al.; paragraphs [0111]-[0115]).

As per claim 32, Freedman et al. teaches a computer-readable data transmission medium between a plurality of computers having a data structure comprising: a first subset of data for processing at a first computer, the first subset of data including information regarding processing, monitoring and detection of a contract (Freedman et al.; paragraphs [0097] [0100] [0109]); and a second subset of data for processing at a second computer, the second subset of data including notification information (Freedman et al.; paragraphs [0100] [0141]-[0143]).

As per claim 33, Freedman et al. teaches an automated method for processing an insurance claim comprising: providing a front-end subsystem in communication with at least one of a client, an insurance vendor and an insurance partner (Freedman et al.; paragraphs [0027] [0097] [0103]), a database subsystem accessing a plurality of stored databases (Freedman et al.; paragraphs [0011] [0113]) and a back-end subsystem in communication with a plurality of subsystems to source information, monitor the creation, and administration of an insurance contract (Freedman et al.; paragraphs [0068] [0072] [0103] [0113]); receiving a claim from a client using the front-end subsystem (Freedman et al.; paragraph [0126]); validating the eligibility of the claim by accessing the information in the plurality of databases (Freedman et al.; paragraphs [0125]

[0126] [0130]); adjudicating the claim (Freedman et al.; paragraphs [0125] [0126] [0130]); and

sending authorization signals to a data processor in order to dispense the funds associated with

the claim (Freedman et al.; paragraphs [0118] [0130] [0134]).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine

grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection

is appropriate where the conflicting claims are not identical, but at least one examined

application claim is not patentably distinct from the reference claim(s) because the examined

application claim is either anticipated by, or would have been obvious over, the reference

claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re

Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re

Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163

USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may

be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the

scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal

disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR

3.73(b).

[3]   Claims 1-32 are provisionally rejected on the ground of nonstatutory obviousness-type

double patenting as being unpatentable over claims 1-32 of copending Application No.

10/135,191. Although the conflicting claims are not identical, they are not patentably distinct

from each other because claims 1-32 of Application #10/697,719 are overlapping in scope claims

1-32 of Application #10/135,191.

This is a provisional obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

Conclusion

[4]   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Pescitelli et al., INTERACTIVE SELF-SERVICE VENDING SYSTEM, United States Patent

#5,845,256

Ogawa et al., TECHNIQUE FOR GENERATING INSURANCE PREMIUM QUOTES BY

MULTIPLE VENDORS IN RESPONSE TO A SINGLE USER REQUEST, United States Patent

Application Publication #2001/0023404

Bauer et al., METHOD AND APPARATUS FOR INTERNET ON-LINE INSURANCE

POLICY SERVICE, United States Patent Application Publication #2002/0116228

Hele et al., SELLING INSURANCE OVER A NETWORKED SYSTEM, United States Patent

Application Publication #2002/0116231

Labelle et al., SYSTEM AND METHOD OF DISPENSING INSURANCE THROUGH A

COMPUTER NETWORK, United States Patent Application Publication #2002/0120476

Nauert et al., ON-LINES METHOD OF LINKING AGENTS AND CUSTOMERS, United

States Patent Application Publication #2003/0200122.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Robert D. Rines whose telephone number is 571-272-5585. The

examiner can normally be reached on 8:30am - 5:00pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RDR

C. LUKE GILLIGAN
PATENT EXAMINER